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| 26646 7590 09/15/2009 KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004 | | | | |
| EXAMINER ZEWARI, SAYED T | | | | |
| ART UNIT 2617 | | PAPER NUMBER | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/534,768

Applicant(s)

BAUMKOETTER, MANFRED

Examiner

SAYED T. ZEWARDI

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

Objections

Specification

1. The applicant has submitted a new specification. Therefore the objection to specification is withdrawn.

Drawings

2. The applicant has partly corrected the drawing but failed to provide a flow chart outlining the operation of their invention, as was pointed out in previous office action. Therefore the objection to drawing is maintained.

Response to Amendment

3. Applicant's arguments filed on 7/08/2009 have been fully considered but they are not persuasive.
4. Applicant argues that
In contrast, claim 19 of the present application is directed to a method and system for providing a communication path to a mobile telephony network so that a telecommunication connection is set up between a telecommunication terminal designed to be used in a mobile telephony network and a distant terminal, and requires: using at least one of a radio communication (radio path) and an Internet

connection as a connecting path between the telecommunication terminal and access and switching units of the mobile telephony network, ...

This argument is not persuasive because the applied references disclose these limitations. The applicant discloses a method and system of establishing connection through internet. The applied references also disclose such a communication and setup.

5. Applicant argues that

As discussed above, it is not believed that the Lee and Labun references disclose each of these features as claimed. The Staples and Stein references do not cure the deficiencies of the Lee and Labun reference since they refer to use of a PC card and a specific housing for a transceiver.

This argument is not persuasive. The applied references disclose a method and system of establishing communication via internet. The use of a specific housing for a transceiver, in this communication system, has not relevance to claim limitations.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 19-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al. (US 6,847,632) in view of Labun et al. (US 2003/0,119,527).

With respect to claim 19, Lee discloses a method for providing a communication path to a mobile telephony network (**See Lee's abstract, col.1 lines 36-50, 59-63, col.2 lines 1-33**) so that a telecommunication connection is set up between a telecommunication terminal designed to be used in a mobile telephony network and a distant terminal (**See Lee's figure 2(50), col.4 lines 31-32, col.6 lines 10-21, 22-67, col.7 lines 1-67, col.8 lines 1-11**), comprising: utilizing at least one of a radio communication (radio path) and a connection that includes the Internet (Internet connecting path) as a connecting path between the telecommunication terminal and access and switching units of the mobile telephony network (**See Lee's radio path: figure 2(50, 98), Internet connecting path: figure 2(98, 120, 123, 110), access & switching unit: 62) col.4 lines 31-32, col.6 lines 10-21, 22-67, col.7 lines 1-67, col.8 lines 1-11**), by one of optionally, automatically, and initiated by a user of the telecommunication terminal (**See Lee's col.3 lines 14-35**), the access and switching units and the telecommunication terminal treating the Internet connecting path like another radio cell of the mobile telephony network with respect to sequences that are connected to an activation of the telecommunication terminal and its respective one of check-in and booking into the mobile telephony network (**See Lee's access & switching unit: figure 2(62), figure 1, col.4 lines 65-67, col. 5 lines 13**). Lee discloses everything claimed as applied above to claim 19 except for explicitly reciting

switchover of the connecting path between radio path and Internet path or vice versa implemented in a changeover or a handover. In analogous art, Labun discloses switchover of the connecting path between cellular and non-cellular network for the purpose of splitting the aspects of control and media content from a cellular network connection (**See Labun's abstract, figure 1, see section [0001]-[0006], [0036]**). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Lee and combine with it with the invention of Labun by specifically with switching capability between a cellular and non-cellular networks, thereby providing terminal that is capable of using cellular and non-cellular networks, as described by Labun.

With respect to claim 28, Lee discloses a system for implementing a method for providing a communication path to a mobile telephony network (**See Lee's abstract, col.1 lines 36-50, 59-63, col.2 lines 1-33**) according to which, to set up a telecommunication connection between a telecommunication terminal designed to be used in a mobile telephony network and a distant terminal (**See Lee's figure 2(50), col.4 lines 31-32, col.6 lines 10-21, 22-67, col.7 lines 1-67, col.8 lines 1-11**), a radio communication or a connection that includes the Internet is utilized as connecting path between the telecommunication terminal and the access and switching units of the mobile telephony network (**See Lee's radio path: figure 2(50, 98), Internet connecting path: figure 2(98, 120, 123, 110), access & switching unit: 62) col.4 lines 31-32, col.6 lines 10-21, 22-67, col.7 lines 1-67, col.8 lines 1-11**),, by at least one of optionally, automatically, and initiated by a user of the telecommunication

terminal (**See Lee's col.3 lines 14-35**), the access and switching units and the telecommunication terminal treating the Internet connecting path like another radio cell of the mobile telephony network as far as the sequences are concerned that are connected to the activation of the telecommunication terminal and its check-in or booking into the mobile telephony network (**See Lee's access & switching unit: figure 2(62), figure 1, col.4 lines 65-67, col. 5 lines 13**), comprising: a telecommunication terminal provided for use in a mobile telephony network; an Internet access unit able to be networked with the telecommunication terminal in a Local Area Network (**See Lee's figure 5(519, 508, 550, 517-518, 555), col.10 lines 39-54**); and an access and switching unit of the mobile telephony network, which is Internet protocol-addressable via the Internet and integrated in the infrastructure of a mobile telephony network in which the mobile telecommunication terminal is able to be used (**See Lee's access & switching unit: figure 2(62), figure 1, col.4 lines 65-67, col. 5 lines 13**). Lee discloses everything claimed as applied above to claim 28 except for explicitly reciting switchover of the connecting path between radio path and Internet path or vice versa implemented in a changeover or a handover. In analogous art, Labun discloses switchover of the connecting path between cellular and non-cellular network for the purpose of splitting the aspects of control and media content from a cellular network connection (**See Labun's abstract, figure 1, see section [0001]-[0006], [0036]**).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Lee and combine with it with the invention of Labun by specifically with switching capability between a cellular and non-cellular networks,

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thereby providing terminal that is capable of using cellular and non-cellular networks, as described by Labun.

With respect to claim 33, Lee discloses a telecommunication terminal for implementing a method for providing a communication path to a mobile telephony network (**See Lee's abstract, col.1 lines 36-50, 59-63, col.2 lines 1-33**) according to which, to set up a telecommunication connection between a telecommunication terminal designed to be used in a mobile telephony network and a distant terminal (**See Lee's figure 2(50), col.4 lines 31-32, col.6 lines 10-21, 22-67, col.7 lines 1-67, col.8 lines 1-11**), a radio communication (radio path) or a connection that includes the Internet (Internet connecting path) is utilized as connecting path between the telecommunication terminal and the access and switching units of the mobile telephony network (**See Lee's radio path: figure 2(50, 98), Internet connecting path: figure 2(98, 120, 123, 110), access & switching unit: 62) col.4 lines 31-32, col.6 lines 10-21, 22-67, col.7 lines 1-67, col.8 lines 1-11**), by one of optionally, automatically, and initiated by a user of the telecommunication terminal (**See Lee's col.3 lines 14-35**), the access and switching units and the telecommunication terminal treating the Internet connecting path like another radio cell of the mobile telephony network as far as the sequences are concerned that are connected to the activation of the telecommunication terminal and its check-in or booking into the mobile telephony network (**See Lee's access & switching unit: figure 2(62), figure 1, col.4 lines 65-67, col. 5 lines 13**), comprising: a mobile telephone (**See Lee's figure 5, col.4 lines 40-41, col.10 lines 4-5**) having functional units for operation in a mobile telephony network (**See Lee's figure 5(519-520, 57-518)**),

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col.10 lines 39-54) and a control unit (**See Lee's figure 5(519-520, 57-518), col.10 lines 39-54)** with a memory (**See Lee's figure 5(519-520, 57-518), col.10 lines 39-54)** and means for integrating the device in a Local Area Network (**See Lee's figure 5(519, 508, 550, 517-518, 555), col.10 lines 39-54)**, the control unit inherently controlling the switch between different operating modes with respect to at least one of an exclusively mobile-telephony-based or an at least partially Internet-based telecommunication (**See Lee's figure 5(519, 508, 550, 517-518, 555), col.10 lines 39-54)**, wherein in Internet operation, Local Area Network-based data exchange occurs with an Internet access unit (**See Lee's col.11 lines 13-30)**. Lee discloses everything claimed as applied above to claim 33 except for explicitly reciting switchover of the connecting path between radio path and Internet path or vice versa implemented in a changeover or a handover.

In analogous art, Labun discloses switchover of the connecting path between cellular and non-cellular network for the purpose of splitting the aspects of control and media content from a cellular network connection (**See Labun's abstract, figure 1, see section [0001]-[0006], [0036]**). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Lee and combine with it with the invention of Labun by specifically with switching capability between a cellular and non-cellular networks, thereby providing terminal that is capable of using cellular and non-cellular networks, as described by Labun.

With respect to claim 21, Lee discloses a telecommunication method wherein the Internet connecting path is routed to a mobile switching unit (**See Lee's access & switching unit: figure 2(62), figure 1, col.4 lines 65-67, col. 5 lines 13)**.

With respect to claim 22, Lee discloses a method wherein, if appropriate, an Internet connecting path existing to an access and switching unit of the mobile telephony network is temporarily routed to a geographically more conveniently located access and switching unit, the internet protocol address stored in the telecommunication terminal during configuration of the system being temporarily modified by the particular access and switching unit **(See Lee's access & switching unit: figure 2(62), figure 1, col.4 lines 65-67, col. 5 lines 13).**

With respect to claim 23, Lee discloses a method wherein, prior to a communication set up to one of the access and switching units of the mobile telephony network, a query is made at a server under transmission of information regarding the actual radio area of the telecommunication terminal, as a result of which the server transmits to the telecommunication terminal the internet protocol address of an access and switching unit of the mobile telephony network to be addressed **(See Lee's access & switching unit: figure 2(62), figure 1, col.4 lines 65-67, col. 5 lines 13).**

With respect to claim 24, Lee discloses a method wherein, if telecommunication connections are set up utilizing the Internet connecting path, the access and switching units of the mobile telephony network change the rate structure for these telecommunication connections **(See Lee's access & switching unit: figure 2(62), figure 1, col.4 lines 65-67, col. 5 lines 13).**

With respect to claim 25, Lee discloses a method wherein, as it regards the telecommunication terminal, the method allows incoming and outgoing communications to be set up utilizing the Internet connecting path, the Internet with the instantaneous

Internet protocol address and possibly additional address data regarding the telecommunication terminal being stored as location information for the incoming connections in a location register of the access and switching units of the mobile telephony network (**See Lee's access & switching unit: figure 2(62), figure 1, col.4 lines 65-67, col. 5 lines 13).**

With respect to claim 26, Lee discloses a method wherein the Internet address and the number of the ports used for the communication by means of an Internet protocol are continuously updated by an inherent cyclical data exchange (**See Lee's access & switching unit: figure 2(62), figure 1, col.4 lines 65-67, col. 5 lines 13).**

With respect to claim 20, Lee discloses a telecommunication method wherein the Internet connecting path is set up via an Internet access unit (**See Lee's abstract, col.1 lines 36-50, 59-63, col.2 lines 1-33**), which is able to be networked with the telecommunication terminal in a Local Area Network (**See Lee's figure 5(519, 508, 550, 517-518, 555), col.10 lines 39-54**) and one of the access and switching units of the mobile telephony network is addressed by the telecommunication terminal via the Internet access unit and the Internet by means of an inherent internet protocol address, the Local Area Network connection of the telecommunication terminal to the Internet access unit being set up in a conventional fashion, in a wirebound manner, via one of radio, wireless Local Area Network, optics, and infrared transmission (**See Lee's radio path: figure 2(50, 98), Internet connecting path: figure 2(98, 120, 123, 110), access & switching unit: 62) col.4 lines 31-32, col.6 lines 10-21, 22-67, col.7 lines 1-67, col.8 lines 1-11).**

With respect to claim 27, the above combinations disclose all the limitations of claim 27.

With respect to claim 29, Lee discloses a system wherein the telecommunication terminal is a transmission control system having a functional unit for mobile telephony communication **(See Lee's figure 5, col.4 lines 40-41, col.10 lines 4-5).**

With respect to claim 34, the above discloses a terminal wherein the means for integration in the Local Area Network is a unit for at least one of the wireless-based connection to the Local Area Network and the radio-based connection to the Local Area Network **(See Lee's radio path: figure 2(50, 98), Internet connecting path: figure 2(98, 120, 123, 110), access & switching unit: 62) col.4 lines 31-32, col.6 lines 10-21, 22-67, col.7 lines 1-67, col.8 lines 1-11).**

With respect to claim 35, Lee discloses a terminal wherein the means for integration into the Local Area Network is a unit for the optical in-coupling into the Local Area Network **(See Lee's radio path: figure 2(50, 98), Internet connecting path: figure 2(98, 120, 123, 110), access & switching unit: 62) col.4 lines 31-32, col.6 lines 10-21, 22-67, col.7 lines 1-67, col.8 lines 1-11).**

8. Claims 30, 32, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al. (US 6,847,632) in view of Staples (US 6,009,151) and further in view of Stein (US 5,628,055) and still further in view of Labun et al. (US 2003/0,119,527).

With respect to claim 36, Lee discloses a telecommunication terminal for implementing a method for providing a communication path to a mobile telephony network (**See Lee's abstract, col.1 lines 36-50, 59-63, col.2 lines 1-33**) according to which, to set up a telecommunication connection between a telecommunication terminal designed to be used in a mobile telephony network and a distant terminal (**See Lee's figure 2(50), col.4 lines 31-32, col.6 lines 10-21, 22-67, col.7 lines 1-67, col.8 lines 1-11**), a radio communication or a connection that includes the Internet is utilized as connecting path between the telecommunication terminal and the access and switching units of the mobile telephony network (**See Lee's radio path: figure 2(50, 98), Internet connecting path: figure 2(98, 120, 123, 110), access & switching unit: 62) col.4 lines 31-32, col.6 lines 10-21, 22-67, col.7 lines 1-67, col.8 lines 1-11**), by one of optionally, automatically, and initiated by a user of the telecommunication terminal (**See Lee's col.3 lines 14-35**), the access and switching units and the telecommunication terminal treating the Internet connecting path like another radio cell of the mobile telephony network as far as the sequences are concerned that are connected to the activation of the telecommunication terminal and its check-in or booking into the mobile telephony network (**See Lee's access & switching unit: figure 2(62), figure 1, col.4 lines 65-67, col. 5 lines 13**), comprising: Lee discloses everything claimed as applied above to claim 36, except for explicitly reciting a laptop with some limitations listed below. In analogous art, Staple discloses a laptop having a network card for one of a wire-bound and a wireless connection to a Local Area Network (**See Staple's figure 1(20), figure 2, col.5 lines 54-67, col.1 lines 31-67**), a soundcard (**See Staple's col.2**

lines 28-36, figure 6(124)), and a chip-card reader for reading chip cards of a mobile telephony operator, wherein the laptop is designed at least to utilize the mobile telephony network while establishing a connection routed via the Internet (**See Staple's col.2 lines 28-36, figure 6(180, 192, 30)**). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Lee and combine with it with the invention of Staples specifically by using a laptop as communication device, thereby providing terminal that is a laptop with sound and network card as disclosed above.

Further, the above combinations of Lee and staples disclose everything claimed as applied above to claim 36, except for explicitly reciting headset for voice communication. In analogous art, Stein discloses a headset for listening to communication (**See Stein's figure 14(320, 316)**). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Lee and Staples and combine with it with the invention of Stein specifically by including the use of a headset for communication for the purpose of providing terminal that is a laptop with sound and network card having a headset for communication.

Further the above combinations disclose everything claimed as applied above to claim 36 except for explicitly reciting switchover of the connecting path between radio path and Internet path or vice versa implemented in a changeover or a handover.

In analogous art, Labun discloses switchover of the connecting path between cellular and non-cellular network for the purpose of splitting the aspects of control and media content from a cellular network connection (**See Labun's abstract, figure 1, see**

section [0001]-[0006], [0036]). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Lee and combine with it with the invention of Labun by specifically with switching capability between a cellular and non-cellular networks, thereby providing terminal that is capable of using cellular and non-cellular networks, as described by Labun.

With respect to claim 30 and 32, the above combinations disclose all the limitations of claims 30 and 32.

9. Claims 31 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable Lee et al. (US 6,847,632) in view of well-known prior art (MPEP 2144.03).

With respect to claim 31 and 37, Lee discloses all limitations. Lee does not disclose the system to be DSL-enabled. However, an official notice is taken that the concept and use of DLS well known and expected in the art. Therefore, it would be obvious to one of ordinary skill in the art to design the system in such a way that incorporates the use of DLS.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SAYED T. ZEWARDI whose telephone number is (571)272-6851. The examiner can normally be reached on 8:30-4:30.

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11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester G. Kincaid can be reached on 571-272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sayed T Zewari/

Examiner, Art Unit 2617

/Lester Kincaid/

Supervisory Patent Examiner, Art Unit 2617